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EXAMINER				
SHEDRICK, CHARLES TERRELL				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
02/04/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tammy@ppglaw.com

# Office Action Summary

**Application No.**

10/551,892

**Applicant(s)**

PALENIUS ET AL.

**Examiner**

CHARLES SHEDRICK

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/06/08 have been fully considered but they are not persuasive.
2. Applicant argues Jokinen does not disclose any synchronization of measurement events within a portable radio communication apparatus providing multiple radio access technologies, but instead shows the transmittal of information, concerning handover between cells using different radio access technologies, from a cellular network to a mobile station.
3. However, the Examiner respectfully disagrees. Jokinen teaches inasmuch as outlined in the claims at least synchronization of measurement events within a portable radio communication apparatus providing multiple radio access technologies. Consider given the broadest reasonable interpretation any at least two devices and/or distributed logic of the prior art would read on the first radio access technology device and the second radio access technology device based on the claim language as long as the device and or distributive logic provides the particular function of the first and/or second access technology. Furthermore, even at least the circuitry of the prior art would read on a first radio access device and a second radio access device since it follows that the internal circuitry (not shown) would carry the first and second device/logic providing the external function. Furthermore MPEP 2144.04 states that the court has held that *the mere duplication of parts has no patentable significance unless a new and unexpected result is produced*. The language of Claim 12 further indicates that the first and second technologies are simply operatively connected and adapted to. The Examiner respectfully submits that the manner of operating the device does not differentiate apparatus

claim the Prior art MPEP 2114. It has also been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform, it does not constitute a limitation in any patentable sense.

4. In response to applicant's argument that in Jokinen the mobile station does not identify an idle gap between transceiver activities of a first radio access technology device suitable for usage by a second radio access technology device, but instead uses the idle mode of the mobile station to obtain dynamic configurations, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. Applicant argues that Jokinen additionally lacks any teaching of sending an execute signal from the first to the second radio access technology devices within the portable radio communication apparatus, and instead sends a control signal from the base station to the mobile station.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., sending an execute signal from the first to the second radio access technology devices within the portable radio communication apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, The Examiner respectfully submits that inasmuch as the claim language outlines the prior art teaches sending an execute signal from the first to the second radio access technology devices within the

portable radio communication apparatus since any at least two devices and/or distributed logic could read on the first radio access technology device and the second radio access technology device based on the claim language as long as the device and or distributive provides the particular function of the first and/or second access technology.

7. For at least the foregoing reasons, independent claims 1 and 12, as well as claim 12's dependent claims 13-15, are believed to define subject matter that is not novel and obvious over that which is disclosed by Jokinen.
8. Claims 2-11 all depend from independent claim 1, and are therefore not patentably distinguishable over the Jokinen document for at least the same reasons as those set forth above.

#### DETAILED ACTION

##### *Claim Rejections - 35 USC § 101*

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. **Claim 1** is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the **synchronizing measurement event** method including step of identifying is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. **The Applicant has provided**

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

**no explicit and deliberate definitions of "identifying" to limit the steps to the "events" (i.e., what or who identifies the idle gap ?)**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Jokinen et al., WO/0237868, hereinafter, "**Jokinen**".

Consider **claims 1 and 12**, Jokinen teaches a method and portable radio communication Apparatus (i.e., **Claims 1 and 12 are directed towards identical subject matter**) for synchronizing of a portable radio communication apparatus providing multiple radio access technologies including a first radio access technology device and a second radio access technology device, comprising the steps of: identifying an idle gap between transceiver activities of the first radio access technology device suitable for usage by the second radio access technology device(e.g., see at least page 25 lines 19-24 and remarks above in response to arguments ), and sending an execute signal from the first radio access technology device to the second radio access technology device for initiating inter radio access technology measurements of said second radio access technology device to be performed during said gap(i.e., intersystem handover procedure as described on page 14 line 25- page 16 line 2 and remarks above in response to arguments)(noting also the signaling that follows from within a multimode device internally).

Consider **claim 13 and as applied to claim 12**, Jokinen teaches wherein said first and second radio access technology devices have common radio resource means for said inter radio access technology measurements (i.e., **common resources to negotiate handoff as described on page 14 line 25- page 16 line 2**).

Consider **claim 14 and as applied to claim 12**, Jokinen teaches wherein said first radio access technology device is a GSM based radio access technology device and said second radio access technology device is a WCDMA radio access technology device( **page 14 line 25- page 16 line 2**).

Consider **claim 15 and as applied to claim 12**, Jokinen teaches wherein said first radio access technology device is a WCDMA based radio access technology device and said second radio access technology device is a GSM radio access technology device (**page 14 line 25- page 16 line 2**).

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokinen et al., WO/0237868, hereinafter, “**Jokinen**” in view of Breuer et al. WO 02/39758, hereinafter, “**Breuer**”

Consider **claim 2 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically wherein said execute signal is sent at the beginning of said gap.

However, in Analogous art, Breuer teaches wherein said execute signal is sent at the beginning of said gap (i.e., **based on parameter of time interval**) (e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 3 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically wherein said execute signal is sent at a specified period before said gap.

However, in Analogous art, Breuer teaches wherein said execute signal is sent at a specified period before said gap (i.e., **based on parameter of time interval**) (e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving



intersystem Handover

Consider **claim 4 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically comprising, before the step of sending an execute signal, the additional step of: sending a prepare signal to said second radio access technology device for information about an upcoming gap available for inter radio access technology measurements of said second radio access technology device.

However, in Analogous art, Breuer teaches before the step of sending an execute signal, the additional step of: sending a prepare signal to said second radio access technology device for information about an upcoming gap available for inter radio access technology measurements of said second radio access technology device(i.e., timeslot indication) (e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 5 and as applied to claim 4**, Jokinen teaches the claimed invention except specifically comprising the further step of: preparing said second radio access technology device for performing said inter radio access technology measurements.

However, in Analogous art, Breuer teaches the claimed invention comprising the further step of: preparing said second radio access technology device for performing said inter radio access technology measurements (i.e., transmitting parameters to aid in intersystem handoff

**decisions) (e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 6 and as applied to claim 5**, Jokinen teaches the claimed invention except specifically wherein said step of preparing said second radio access technology device comprises the step of: bringing said second radio access technology device out of a low-power consuming state.

However, in Analogous art, Breuer teaches wherein said step of preparing said second radio access technology device comprises the step of: bringing said second radio access technology device out of a low-power consuming state (**i.e., the power is adjusted based on mode e.g., compressed mode**) (e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 7 and as applied to claim 5**, Jokinen teaches the claimed invention except specifically wherein said prepare signal includes information about the estimated length of said gap.

However, in Analogous art, Breuer teaches wherein said prepare signal includes information about the estimated length of said gap (**i.e., based on parameter of time interval**)

(e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 8 and as applied to claim 7**, Jokinen teaches the claimed invention except specifically wherein said step of preparing said second radio access technology device comprises the step of: determining whether inter radio access technology measurements are possible during the next gap, based on information about the estimated length of said gap.

However, in Analogous art, Breuer teaches wherein said step of preparing said second radio access technology device comprises the step of: determining whether inter radio access technology measurements are possible during the next gap, based on information about the estimated length of said gap(e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 9 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically wherein said execute signal includes information about the estimated length of said gap.

However, in Analogous art, Breuer teaches wherein said execute signal includes information about the estimated length of said gap (i.e., based on parameter of time interval)

(e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover

Consider **claim 10 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically wherein the step of identifying an idle gap is performed between transceiver activities of a GSM based first radio access technology device and said execute signal is sent to a WCDMA based second radio access technology device for initiating inter radio access technology measurements of said WCDMA based second radio access technology device to be performed during said gap.

However, in Analogous art, Breuer teaches wherein the step of identifying an idle gap is performed between transceiver activities of a GSM based first radio access technology device and said execute signal is sent to a WCDMA based second radio access technology device for initiating inter radio access technology measurements of said WCDMA based second radio access technology device to be performed during said gap(e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover.

Consider **claim 11 and as applied to claim 1**, Jokinen teaches the claimed invention except specifically wherein the step of identifying an idle gap is performed between transceiver

activities of a WCDMA based first radio access technology device and said execute signal is sent to a GSM based second radio access technology device for initiating inter radio access technology measurements of said GSM based second radio access technology device to be performed during said gap.

However, in Analogous art, Breuer teaches wherein the step of identifying an idle gap is performed between transceiver activities of a WCDMA based first radio access technology device and said execute signal is sent to a GSM based second radio access technology device for initiating inter radio access technology measurements of said GSM based second radio access technology device to be performed during said gap(e.g., see page 1 line 20- page 2 line 6, page 2 line 25 - page 3 line 34, page 4 line 17 - page 5 line 14, page 7 line 23 - page 9 line 6)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jokinen to include Breuer for the purpose of improving intersystem Handover.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles Shedrick/  
Examiner, Art Unit 2617

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617